

Remarks

Claims 3, 10, 11, and 13 are amended herein; claims 12 and 14-16 are canceled. The pending claims are now claims 3, 5, 10, 11, and 13. Claim 10 currently stands withdrawn from consideration.

The amendments to claims 3, 10, 11, and 13 are supported throughout the specification, e.g., by the corresponding originally filed claims, originally filed SEQ ID NOS:4 and 5, and the paragraph beginning at page 2, line 6 of the specification.

The sequence listing enclosed herewith includes SEQ ID NOS:1-7. SEQ ID NOS:1-5 are the originally filed SEQ ID NOS:1-5. SEQ ID NO:6 is the EpoR cDNA reported in Winkelman et al., cited at page 2, line 8 of the specification. SEQ ID NO:7 is the EpoR protein reported in Winkelman et al., cited at page 2, line 8 of the specification. Accordingly, the sequence listing does not contain new matter.

The amendments to the specification correct reference to the SEQ IDs. SEQ ID NOS:1-5 were originally filed with the application. SEQ ID NO:4 is the EpoR cDNA sequence reported in Jones et al., cited at page 2, lines 7-8 of the specification. SEQ ID NO:6 is the EpoR cDNA reported in Winkelman et al., cited at page 2, line 8 of the specification. SEQ ID NO:5 is the EpoR protein sequence reported in Jones et al., and SEQ ID NO:7 is the EpoR protein sequence reported in Winkelman et al. The amendments to the specification do not introduce new matter.

Telephonic Conference

Applicant thanks the Examiner for the courtesy of a telephonic conference with the Applicant's attorney on November 24, 2004, during which amendments to the claims that would place the claims in condition for allowance were discussed. Applicant believes based on this discussion that the currently amended claims are in condition for allowance.

Sequence listing

The Examiner requested clarification of the numbering of the SEQ IDs. A complete sequence listing containing SEQ ID NOS:1-7 is enclosed to replace all previous

sequence listings. SEQ ID NOS:1-5 were originally filed. SEQ ID NO:6 is the human EpoR cDNA reported in Winkelman et al., and SEQ ID NO:7 is the human EpoR protein sequence reported in Winkelman et al., cited at page 2, line 8 of the originally filed specification.

The Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph

Claims 3, 5, and 11-14 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

The Examiner stated that the recitation of SEQ ID NO:5 and SEQ ID NO:7 in the claims would provide adequate written description. Claims 3, 5, and 10 now recite SEQ ID NO:5 and SEQ ID NO:7. Claims 11 and 13 recite the EpoR cDNA sequences SEQ ID NO:4 and SEQ ID NO:6. Applicant believes that these amendments obviate this basis for the written description rejection.

The Examiner also objected to the phrase “consisting essentially of” and stated that the Applicant has not described all possible polypeptides consisting essentially of amino acids 25-250 of SEQ ID NOS:5 or 7. To facilitate prosecution of the application, Applicant has amended the claims so that claims 3, 5, 10, and 11 recite an isolated polypeptide consisting of about amino acid 25 to about amino acid 250 of a full length human erythropoietin receptor protein (SEQ ID NO:5 or SEQ ID NO:7). Based on the Office Action and the telephonic conference with the Examiner, Applicant believes that these amendments obviate this basis for the rejection of the claims.

In view of the amendments and remarks herein, it is requested that the Examiner withdraw the rejection of Claims 3, 5, 11, and 13 under 35 U.S.C. § 112, first paragraph.

Withdrawn claim

Claim 10 was withdrawn from consideration as drawn to a non-elected invention. Claim 10 as currently amended contains all the limitations of claim 3. It is believed that claim 3 is in condition for allowance. Claim 3 is a linking claim to a product, linked to

claim 10 directed to a process of using the product of claim 3. M.P.E.P. § 809.03. Following a restriction requirement, “[a]ny claim directed to the nonelected invention, previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be examined for patentability.” M.P.E.P. § 809.

Accordingly, Applicant respectfully requests that the restriction requirement of claim 10 be withdrawn, and that claim 10 be examined for patentability. Since claim 3 is believed allowable and claim 10 includes all the limitations of claim 3, it believed that claim 10 is also allowable.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (651-207-8270) to facilitate prosecution of this application.

Respectfully submitted,

JONG Y. LEE

By her Representatives,

McTavish Patent Firm
429 Birchwood Courts
Birchwood, MN 55110
651-207-8270

Date Nov. 26, 2004

By: Hugh McTavish

Hugh McTavish
Reg. No. 48,341

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United State Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 26 day of November 2004.

Hugh McTavish
Hugh McTavish